

DUPLICATE

PATENT COOPERATION TREATY

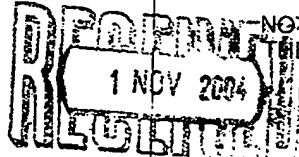
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From the  
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

To:

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PCT



NOTIFICATION OF TRANSMITTAL OF  
THE INTERNATIONAL PRELIMINARY  
EXAMINATION REPORT  
(PCT Rule 71.1)

Date of mailing  
(day/month/year)

28.10.2004

Applicant's or agent's file reference  
PJS/JAS/P8745WO

## IMPORTANT NOTIFICATION

International application No.  
PCT/GB 03/04297

International filing date (day/month/year)  
06.10.2003

Priority date (day/month/year)  
07.10.2002

Applicant  
GARLITO B.V. et al.

1. The applicant is hereby notified that this International Preliminary Examining Authority transmits herewith the international preliminary examination report and its annexes, if any, established on the international application.
2. A copy of the report and its annexes, if any, is being transmitted to the International Bureau for communication to all the elected Offices.
3. Where required by any of the elected Offices, the International Bureau will prepare an English translation of the report (but not of any annexes) and will transmit such translation to those Offices.

## 4. REMINDER

The applicant must enter the national phase before each elected Office by performing certain acts (filing translations and paying national fees) within 30 months from the priority date (or later in some Offices) (Article 39(1)) (see also the reminder sent by the International Bureau with Form PCT/IB/301).

Where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary examination report. It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned.

For further details on the applicable time limits and requirements of the elected Offices, see Volume II of the PCT Applicant's Guide.

The applicant's attention is drawn to Article 33(5), which provides that the criteria of novelty, inventive step and industrial applicability described in Article 33(2) to (4) merely serve the purposes of international preliminary examination and that "any Contracting State may apply additional or different criteria for the purposes of deciding whether, in that State, the claimed inventions is patentable or not" (see also Article 27(5)). Such additional criteria may relate, for example, to exemptions from patentability, requirements for enabling disclosure, clarity and support for the claims.

Name and mailing address of the international  
preliminary examining authority:



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D-80298 Munich  
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Authorized Officer

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# PATENT COOPERATION TREATY

## PCT

### INTERNATIONAL PRELIMINARY EXAMINATION REPORT (PCT Article 36 and Rule 70)

Applicant's or agent's file reference <b>PJS/JAS/P8745WO</b>	<b>FOR FURTHER ACTION</b> See Notification of Transmittal of International Preliminary Examination Report (Form PCT/PEA/416)	
International application No. <b>PCT/GB 03/04297</b>	International filing date ( <i>day/month/year</i> ) <b>06.10.2003</b>	Priority date ( <i>day/month/year</i> ) <b>07.10.2002</b>
International Patent Classification (IPC) or both national classification and IPC <b>C09D11/00</b>		
Applicant <b>GARLITO B.V. et al.</b>		
<p>1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of 5 sheets, including this cover sheet.</p> <p><input type="checkbox"/> This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).</p> <p>These annexes consist of a total of    sheets.</p>		
<p>3. This report contains indications relating to the following items:</p> <ul style="list-style-type: none"> <li>I   <input checked="" type="checkbox"/> Basis of the opinion</li> <li>II   <input type="checkbox"/> Priority</li> <li>III   <input type="checkbox"/> Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</li> <li>IV   <input type="checkbox"/> Lack of unity of invention</li> <li>V   <input checked="" type="checkbox"/> Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</li> <li>VI   <input checked="" type="checkbox"/> Certain documents cited</li> <li>VII   <input checked="" type="checkbox"/> Certain defects in the international application</li> <li>VIII   <input type="checkbox"/> Certain observations on the international application</li> </ul>		
Date of submission of the demand  <b>11.03.2004</b>	Date of completion of this report  <b>28.10.2004</b>	
Name and mailing address of the international preliminary examining authority:   European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Tx: 523656 epmu d Fax: +49 89 2399 - 4465	Authorized Officer  <b>Glomm, B</b>  Telephone No. +49 89 2399-7158 	

**INTERNATIONAL PRELIMINARY  
EXAMINATION REPORT**

International application No. **PCT/GB 03/04297**

**I. Basis of the report**

1. With regard to the **elements** of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17)*):

**Description, Pages**

1-21 as originally filed

**Claims, Numbers**

1-22 as originally filed

**Drawings, Sheets**

1, 2 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).  
☐ the language of publication of the international application (under Rule 48.3(b)).  
☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.  
☐ filed together with the international application in computer readable form.  
☐ furnished subsequently to this Authority in written form.  
☐ furnished subsequently to this Authority in computer readable form.  
☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.  
☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- ☐ the description, pages:  
☐ the claims, Nos.:  
☐ the drawings, sheets:

**INTERNATIONAL PRELIMINARY  
EXAMINATION REPORT**

International application No. PCT/GB 03/04297

5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

*(Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.)*

6. Additional observations, if necessary:

**V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

1. Statement

Novelty (N)	Yes: Claims	
	No: Claims	1-22
Inventive step (IS)	Yes: Claims	
	No: Claims	1-22
Industrial applicability (IA)	Yes: Claims	1-22
	No: Claims	

2. Citations and explanations

**see separate sheet**

**VI. Certain documents cited**

1. Certain published documents (Rule 70.10)

and / or

2. Non-written disclosures (Rule 70.9)

**see separate sheet**

**VII. Certain defects in the international application**

The following defects in the form or contents of the international application have been noted:

**see separate sheet**

Relevant document:

D1: WO 99/29787 A (JOHNSON STEVE ; XAAR TECH LTD (GB);  
WOODS JILL (GB)) 17 June 1999 (1999-06-17)

### **1. Novelty (Art. 33 (2) PCT)**

The novelty objection as pointed out in detail in the first written opinion is maintained in regard to the document D1 as concerns the present set of claims. The considerations of the applicant as provided in his letter dated June 15, 2004 are not convincing for the following reasons 1. to 5.:

- 1.) As regards the discussion of process-related features and/or - advantages, the attention of the applicant is drawn to the fact, that present claim 1 is a (very generally worded) product-claim, based on a "comprising"- wording, which does not exclude any further additives.
- 2.) Furthermore, for sake of completeness, even the addition of process-related features to such a product-related claim may not render such claim novel, unless the product as such is not anticipated (see "Guidelines for examination ....", C-III-4.7.b.)).
- 3.) Features appearing only in dependent claims (or optional features of independent claims) will never render any claim novel (see applicant's said letter, page 2, forth section).
- 4.) Discussion of any specific advantages and/or unexpected effects of the claimed subject matter as done in applicant's said letter (see page 2, second and third section) is a question of inventiveness only, and may also never render any claims novel.
- 5.) The disclosure of a prior art document is not to be limited unduly to the examples or preferred embodiments. Actually, the viewpoint of an average person skilled in the art when reading the whole document in its entirety is decisive (see considerations on page 1 of applicant's letter).

To sum up, the applicant fails to discuss novelty of the claimed subject matter in view of the claimed combination of features of present main claim 1. Actually, the international preliminary examining division still feels unable to identify any technical feature of present claim 1, which is not fully anticipated by said prior art document D1.

Consequently, document D1 anticipates the subject matter of present claim 1.

The same considerations also relate to the additional features of the following claims 2 to 22 when taking into account the full disclosure of document D1.

**Therefore the subject matter of present application is not new in view of the disclosure of document D1.**

## **2. Inventive Step (Art. 33 (3) PCT)**

In view of the above objection, the discussion of the presence of an inventive step is postponed to the subsequent European regional stage, if any. - Providing an amended main claim which meets the requirements of Art. 33 (2) PCT, the applicant should relate the distinguishing feature to a surprising (unexpected) technical effect or make credible or plausible that the distinguishing feature is not derivable from the prior art teaching (Art. 33 (3) PCT).

## **3. Miscellaneous**

When filing amendments, any undue extension of the scope of the application should be avoided.